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MARX, IRENE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,375

Applicant(s)

TATEISHI ET AL

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) 26-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
Paper No(s)/Mail Date 7/25/08, 8/7/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The application should be reviewed for errors.

To facilitate processing of papers at the U.S. Patent and Trademark Office, it is recommended that the Application Serial Number be inserted on every page of claims and/or of amendments filed.

Applicant's election with traverse of Group III, claims 1, 6, 8-9, 14 and 15, now claims 21-24, is acknowledged.

The traversal is on the ground(s) that because there is an alleged technical relationship between the groups which involves the same special technical feature, and because the same standard of unity of invention was not applied as in the International Preliminary Examination authority, the restriction is improper.

In response it is noted that the products of claims 27-31 are products that are distinct from the products being examined, which are directed to a strain of *Talaromyces*. Therefore, the inventions do not match a permitted category as PCT Rule 13.2 which does not provide for multiple methods or products in one category. The further products claimed encompassing at least plants, seed, rock wool and a nursery box, are all different products having different morphological and physiological properties from a fungal strain. The patentability of these products is not dependent on the elected product of Group III.

In addition, the applied art *infra* demonstrates that *Talaromyces* sp. B-422 does not have a special technical feature that distinguishes over the prior art. Therefore, Applicants' arguments are not persuasive with respect to rejoinder of claims 21-26 at this time.

Applicant also argues that because the same standard of unity of invention was not applied as in the International Preliminary Examination authority, the restriction is improper. That no objection to unity of invention was raised in the searching process in the PCT prosecution is not binding in the present case.

The claims as written are drawn to several inventions which are not linked by a special technical feature to form a single general inventive concept as is required for unity of invention.

For the reasons outlined, the arguments are not persuasive of error in the lack of unity requirement made.

Clearly different searches and issues are involved with each group.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL. .

Claims 21-24 are being considered on the merits. Claims 26-31 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is vague and indefinite in the recitation of "synergist". The nature of this additive cannot be readily ascertained even when reading the claim in light of the specification. No definition or example of a "synergist" is provided in this context.

Claim Rejections - 35 USC § 112

Claims 21-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ a strain of *Talaromyces* to obtain a specific product. The written description of that strain and the method of isolating is insufficiently reproducible. Therefore, a deposit for patent purposes is required. The specification discloses at bridging paragraph between pages 6 and 7 that *Talaromyces* B-422 was deposited at National Institute of Biosciences and Human Technology of the Agency of Industrial Science and Technology under Budapest Treaty conditions on October 20, 2003.

For compliance with the rule, it must be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the purpose of Patent Procedure (e.g. see 961 OG 21, 1977) and that all

restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent. MPEP 2403.

Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession) number, date of deposit, name and address of the depository and the complete taxonomic description.

Claim Rejections - 35 USC § 102-103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kim *et al.* (n1990). Glucose oxidase as the antifungal principle of talaron from *Talaromyces flavus*. Can. J. Microbiol. 36: 760-764.)

The claims are drawn to a strain of *Talaromyces* which controls diseases caused by some fungi and bacteria.

The cited reference discloses a strain of *Talaromyces* which appears to be identical to the presently claimed strain (see, e.g., Table I) since it similarly controls diseases caused by some fungi and bacteria, including *Pseudomonas*, reclassified as *Burkholderia*. The referenced

microorganism appears to be identical to the presently claimed strain and is considered to anticipate the claimed microorganism since it is of the same class as that of the microorganism claimed and is taught to be effective against the same types of plant pathogens.

Consequently, the claimed strain appears to be anticipated by the reference.

In the alternative, even if the claimed microorganism is not identical to the referenced microorganism with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced microorganism is likely to inherently possess the same characteristics of the claimed microorganism particularly in view of the similar characteristics which they have been shown to share. Thus the claimed strain would have been obvious to those skilled in the art within the meaning of USC 103.

Regarding the compositions, it is noted that the isolate is one active ingredient therein and that the compositions may contain a "synergist", a definition of which is absent in the present record.

Accordingly, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the reference, especially in the absence of evidence to the contrary.

Claims 21-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marois *et al.* (Plant Diseases. Vol. 66 NO. 12, pages 1166-1168, 1982.)

The claims are drawn to a strain of *Talaromyces* which controls diseases caused by some fungi and bacteria.

The cited reference discloses a strain of *Talaromyces* which appears to be identical to the presently claimed strain (see, e.g., Tables 1 and 2) since it is disclosed as controlling fungal pathogens. The referenced microorganism appears to be identical to the presently claimed strain and is considered to anticipate the claimed microorganism since it is of the same class as that of the microorganism claimed and is taught to be effective against the same types of plant pathogens.

Consequently, the claimed strain appears to be anticipated by the reference.

In the alternative, even if the claimed microorganism is not identical to the referenced microorganism with regard to some unidentified characteristics, the differences between that

which is disclosed and that which is claimed are considered to be so slight that the referenced microorganism is likely to inherently possess the same characteristics of the claimed microorganism particularly in view of the similar characteristics which they have been shown to share. Thus the claimed strain would have been obvious to those skilled in the art within the meaning of USC 103.

Regarding the compositions, it is noted that the isolate is one active ingredient therein and that Table 2 discloses the strain in combination with a chemical which is at least a synergist.

Accordingly, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the reference, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/
Primary Examiner
Art Unit 1651